

REMARKS/ARGUMENTS

In the Office action dated November 7, 2003, the Examiner rejected claim 4, the only pending claim.

In the Specification, no changes.

In the Claims, claim 4 cancelled, new claim 7 added.

The present RCE patent application is filed in response to the final Office Action dated November 7, 2003 in the immediate parent case.

In this RCE patent application, by virtue of entry of the present Preliminary Amendment, and as a consequence of prior prosecution activity in this case, claims 1-6, inclusive, have been cancelled without prejudice, and new claim 7 is added. Thus, as a consequence of entry of this Preliminary Amendment, there will exist in this RCE case a single, independent claim.

Immediately prior to the preparation and filing of this RCE patent application, applicants' attorney of record, Jon M. Dickinson, engaged in an exchange of telephonic messages with the Examiner relating to applicants' request that the Examiner entertain a proposed introduction into this case of what is now, by this Amendment, added as new claim 7. The Examiner, at the end of that exchange, left a telephonic message for Mr. Dickinson informing him that the Examiner would not entertain any further amendatory action.

With respect to predecessor claims in this case, and specifically with respect to now cancelled claim 4 which, prior to this Amendment, was the only claim in the case, the Examiner applied three formal rejections. The first was based upon 35 U.S.C. § 102, applied solely on the basis of U.S. Patent No. 6,195,917 to Dieckhaus. Additionally, the Examiner secondly rejected

claim 4 under 35 U.S.C. § 103 on the basis of a proposed combination of Dieckhaus and a reference which the Examiner has termed "Rogers". Thirdly, the Examiner rejected claim 4 under 35 U.S.C. § 103 on the basis of a combination of U.S. Patent No. 5,319,867 to Weber, and Rogers.

By the present Amendment which is filed to create an RCE Patent Application, and while applicants disagree with the appropriateness of the Examiner's formal rejections of now-cancelled claim 4, applicants hereby present, in new claim 7, a definition of the invention which very clearly distinguishes the features of the present invention from anything shown or suggested in any one, or in any combination, of the three cited and applied prior art references.

Completely missing from the prior art is a very key structural characteristic of applicants' invention -- a characteristic which is very plainly set forth in new claim 7. Specifically, nowhere in the cited and applied art is there any recognition that a shoe insole should have a structure with respect to which no springing or spring-back response occurs to a load-induced deformation in the insole. This difference between the claimed invention and the cited and applied art is major -- in no way trivial.

The insole of applicants' invention offers cushioning without springy or spring-back response characteristics, whereas the art cited by the Examiner, in all instances proposed by the Examiner for rejection of applicants claims, definitively describes a structure in which "conventional-wisdom" spring-back is present because of the inclusion of springy materials in the structures which are described in this art. No one, save applicants, recognizes that spring-back action must be avoided.

For example, and with respect to the Examiner's use of the Dieckhaus reference

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Docket No. OAE.306 (J-OAER.1011)

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under 35 U.S.C. § 102, Dieckhaus includes in its structure a layer numbered 5, which layer is formed of a “nitrate type of foam”. Such a foam, and in particular a nitrated foam, is definitively a springy material. New claim 7 very clearly points out that applicants’ invention is a non-spring-back shoe insole which includes a cushioning layer structure that is fully responsible for all cushioning behavior in the insole, which layer structure is limited, with regard to cushioning-action response by it to a load-induced deformation, solely to a non-spring-back response.

Given this situation, clearly Dieckhaus cannot be urged successfully to be a § 102 reference.

With regard to the Examiner’s obviousness rejections, and beginning with that rejection which is based upon a combination of Dieckhaus and Rogers, the Examiner suggests replacing layer 4 in Dieckhaus with a material taught by Rogers. Such a substitution, were it permissible, would result in a modified Dieckhaus insole still possessing springy layer 5, and thus, such a modified Dieckhaus structure, in response to a load deformation, would clearly exhibit a spring-back action which is to be avoided, and which is specifically avoided by applicants’ claimed invention.

The second obviousness-type rejection proposed by the Examiner is based upon the suggested combination of Weber with Rogers. Weber, however, also does not teach or suggest a non-springy insole structure. Significantly, the specification in Weber identifies, in column 4, a cushioning layer which is formed of any one of a number of named materials, each of which is knowingly springy in nature. The success of the Weber structure in its intended purpose requires the presence of a springy layer structure. Thus the Examiner’s proposed combination of Weber

and Rogers, if permissible, would produce, at best, a modified insole structure which would defeat one of the very purposes of Weber to provide a cushioning layer 12 which has a definitive springy characteristic. In other words, such a combination would have to take place in the context, effectively, of destroying the Weber structure with respect to its intended springy behavior. Nothing in the known art leads to this kind of a destructive combination.

For these reasons, applicants assert that their invention, as now set forth in new claim 7, is clearly patentable over the cited and applied art. Thus, applicants respectfully request favorable action on new claim 7, and early issuance of a Notice of Allowance.

In light of the foregoing amendment and remarks, the Examiner is respectfully requested to reconsider the rejections and objections state in the Office action, and pass the application to allowance. If the Examiner has any questions regarding the amendment or remarks, the Examiner is invited to contact Attorney-of-Record Jon M. Dickinson, Esq., at 503-504-2271.

Request for Extension of time in Which to Respond

Applicants hereby request a one-month extension of time under 37 C.F.R. § 1.136.

A PTO Form 2038 credit card authorization is enclosed, which includes payemtn of the \$385.00 RCE fee for a small entity, and th \$55.00 fee for a one-month extension. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

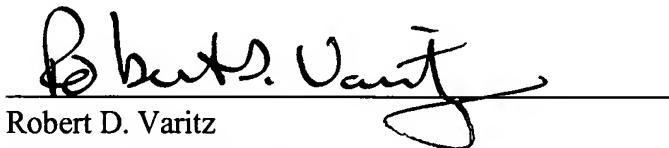
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Respectfully Submitted,

23855

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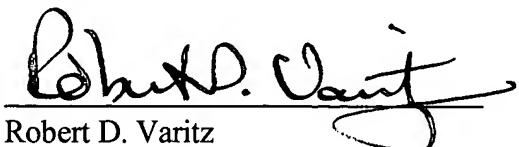
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I hereby certify that the attached PRELIMINARY AMENDMENT IN SUPPORT OF RCE UNDER 37 C.F.R. § 1.111 and a PTO-2038 credit card authorization form in the amount of \$ 440.00 are being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 C.F.R. 1.10 on the date indicated above and is addressed to:

MS RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450


Robert D. Varitz

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